

REMARKS

This Amendment is filed in response to the non-final Office Action dated May 21, 2009, and is respectfully submitted to be fully responsive to the rejections raised therein. Accordingly, favorable reconsideration on the merits and allowance are respectfully requested.

In the present Amendment, claim 1 is amended to incorporate the limitations of claim 9, which is indicated to be allowable if rewritten into an independent claim form, and claim 9 is canceled accordingly. In addition, formula (I) in claim 1 is replaced with the formula (IA-2-1), which is a representative embodiment of formula (I). Additionally, the definitions for ring B and X have been limited to the recited groups. Support for the amendment to claim 1 can be found in the specification on page 34, lines 16-22, original claims 9 and 12, and in the examples, such as, Example 31(69), wherein X is -O-, for example.

Claim 1 has been further amended to recite that when X is -O- or -CH₂-O- and ring A is phenyl, m is an integer of 1 to 7. Support for this amendment to claim 1 can be found in the original specification, e.g., working examples: 31(55), 31(60), 31(61), 31(62), 31(69), 31(76), 31(77), 37(8), 37(12). ~~The above compounds are compounds of formula (IA-2-1) wherein ring A is a phenyl, m is an integer 1, and X is -O- or CH₂-O-~~.

Claims 2-4, 6-15, 17, 18, 21, 23, 24, 26, 36, 42 and 43 have been canceled.

Claims 5 and 19 are amended to depend from claim 1.

Claim 16 is amended to depend from claim 1 and define Y¹⁻³ as -CH₂-, (CH₂)₂ or -(CH₂)₃-. Support for the amendment to claim 16 can be found in the specification on page 34, lines 18-21, for example.

Claim 20 has been amended to additionally recite ethyl, propyl and butyl as definitions of R¹. Support for the amendment can be found in the specification in Example 31-88, Example 31-60 and Example 31-61.

Claim 22 is amended to be within the scope of claim 1.

Claim 25 is amended to depend from claim 1 and to delete compounds other than (11), (14) and (15), which are included in the scope of the amended claim 1. The compound in (14) 1-(6-[3-(4-chlorophenyl)propoxy]-1-methyl-3,4-dihydro-2-naphthalenylmethyl)-3-azetidinecarboxylic acid and (15) 1-(6-[3-(4-fluorophenyl)propoxy]-1-methyl-3,4-dihydro-2-naphthalenylmethyl)-3-azetidinecarboxylic acid are the compounds described in Example 31-44 and Example 31-53, respectively. The compound in Example 31-44 is disclosed in the specification as 1-({6-[3-(4-chlorophenyl)propoxy]-1-methyl-3,4-dihydro-2-naphthalenyl}methyl)-3-azetidinecarboxylic acid hydrochloride. The compound in Example 31-53 is disclosed as 1-({6-[3-(4-fluorophenyl)propoxy]-1-methyl-3,4-dihydro-2-naphthalenyl}methyl)-3-azetidinecarboxylic acid. Claim 25 has been amended to insert the brackets { } in the nomenclature.

Claims 27, 37, 40 and 41 have been amended to delete the phrase “a solvate thereof” and also to recite formula (IA-2-1).

No new matter is believed to have been added. Entry of the Amendment is respectfully submitted to be proper. Upon entry of the Amendment, claims 1, 5, 16, 19, 20, 22, 25, 27-35 and 37-41 will be all the claims pending in the application.

I. Foreign Priority

The Examiner has acknowledged Applicants' claim for foreign priority under 35 U.S.C. § 119 (a-d), and has confirmed receipt of copies of certified documents of Applicants' foreign priority documents. In this regard, applicants note that PAIR shows only foreign priority information: JP 2003-306088, filed August 29, 2003. The publication of the instant application also indicates only one foreign priority information, omitting all other applications: JP 2004-110573, filed April 2, 2004, JP 2004-169958, filed June 8, 2004 and JP 2004-198523, filed July 5, 2004. Applicants respectfully request acknowledgement and consideration of all the priority applications as filed in the present application.

II. Paragraphs 2-7 and 11-12: Election/Restriction

Applicants' affirm the election of Group I, claims 1-39, and species election of 1- {[1-methyl-6-(4-phenylbutoxy)- 3, 4-dihydro-2-naphthalenyl]methyl} -3-azetidinecarboxylic acid have been acknowledged.

Applicants acknowledge that the Examiner has found that the elected species is allowable. Ant that the Examiner has extended the examination to the compound of Formula (I) as recited in claim 1 wherein:

R¹ is a substituent;

A is a cyclic group;

n is 0 or 1, wherein when n is 0, m is 1;

B is a cyclic group;

X is a spacer atom; and

Y is a spacer which forms a ring.

III. Paragraph 20: Allowable Subject Matter

Claims 8, 9, 19, 20, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In accordance with amendments to claim 1, which incorporates limitations of claim 9, claims 8 and 9 have been canceled and therefore the objection is rendered moot.

Claims 19, 20 and 25 have been amended and it is believed that these claims are now in condition for allowance. Allowance of these claims is respectfully requested.

IV. Paragraphs 8-10 and 20: Claim Objections

Claims 1-3, 5-9, 11, 12, 15, 16, 19-21, 25, 27-35, and 37-39 are objected to on the grounds that the claims are allegedly drawn to an improper Markush group.

Applicants respectfully traverse and request that the objection be withdrawn in view of the amendment to claim 1 which recites a compound of formula (IA-2-1). Furthermore, the objection of claims 2, 3, 6-9, 11, 12, 15, and 21 is rendered moot because these claims have been canceled without prejudice.

V. Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1, 27, and 37 are rejected under 35 U.S.C. §112, first paragraph, because, according to the Examiner, the specification, while being enabling for making salts of the claimed compounds, does not reasonably provide enablement for making “a solvate” of the claimed compounds.

Applicants respectfully request withdrawal of the rejection in view of the amendments to the claims wherein the phrase “a solvate” has been deleted from the claim language.

VI. Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 3 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Applicants respectfully request that the rejection be withdrawn as the rejection is rendered moot by the cancellation of claim 3.

VII. Paragraphs 17 and 18: Rejection Under 35 U.S.C. § 102(b)

Claims 1-3, 5-7, 11, 12, 15, 16, 21, 27-35, and 37-39 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Shen *et al.*, Archiv der Pharmazie, 1995, 328(2), 197-201 (Shen).

Applicants respectfully traverse.

Claim 1 has been amended to recite a compound of formula (IA-2-1) wherein ring B may represent dihydronaphthalene, indene, or 6,7-dihydro-5H-benzo[7]annulene. The definition of

ring B is originally recited in claim 9, which is indicated to be allowable if rewritten into an independent claim form. The cited publication fails to teach the compound of formula (IA-2-1) defined in amended claim 1. Thus, the compound as recited in amended claim 1 is not anticipated by the cite publication.

Claims 5, 16, 27-35 and 37 and 39 depend from claim 1 and are therefore patentable over the cite prior art for at least the reasons mentioned with respect to claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: November 20, 2009

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